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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,368	07/09/2001	Nithyalakshmi Sampathkumar	MS180587.1	6483

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/901,368

Applicant(s)

SAMPATHKUMAR ET AL.

Examiner

Nathan Hillery

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-19.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100

Continuation of 3. NOTE: since the amendments to the claims seek to overcome the rejections made under 35 USC 101 and 112, second paragraph, the amendments would require further search and/or consideration especially under 35 USC 103 because the amendments significantly change the scope and interpretation used in the rejections.

Continuation of 11. does NOT place the application in condition for allowance because:
It should be noted that the arguments regarding 35 USC 101 for being inoperative are directed to the newly amended claim language.

Regarding the rejection under 35 USC 101 for being nonstatutory:

To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

The claimed invention "transforms" an article or physical object to a different state or thing.

The claimed invention otherwise produces a useful, concrete and tangible result

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p 19)

The Office maintains that the claims do neither.

Physical transformation occurs when the claimed invention transforms an article or physical object to a different structural state or thing. Physical transformation is an indication that the claim is statutory because such a transformation itself is a useful, tangible and concrete result. However, data transformation is not a physical transformation. Data, by definition, is intangible, so the claim must go further to have a tangible result. Thus, manipulation of data in a computer is not, in and of itself, sufficient for establishing that a claim is statutory. Likewise, a physical act is not necessarily a physical transformation.

The next step in analysis involves determining whether the claims produce a concrete, useful and tangible result.

Regarding a useful result, the disclosure may have met the requirements for utility, but what's claimed does not produce a result that reflects it or is too preliminary in and of itself to be a useful result. In this case, the claimed invention does not provide a useful result even though an appropriate utility has been disclosed, and a rejection as non-statutory is appropriate.

Specifically, by applicant's own admission claims 1 and 19 recite independent acts that "facilitate" the processing of XML items from one format to a second format "that can be" output from the transformation system (Arguments, p 7, second paragraph, lines 9 - 13). The Office maintains that without actually performing or without necessarily requiring that the XML items be processed or output, the result is not useful and has no practical application. The claimed invention is too preliminary to provide the practical application intended by Applicant.

In addition, when the examiner has reason to believe that the claim is not for a practical application that produces a useful result, the claim should be rejected, thus requiring the applicant to distinguish the claim from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application. In such cases, statements in the specification describing a practical application may not be sufficient to satisfy the requirements for section 101 with respect to the claimed invention. Likewise, a claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application. In other words, if the specification discloses a practical application of a § 101 judicial exception, but the claim is broader than the disclosure such that it does not require a practical application, then the claim must be rejected (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p 21)

Regarding a tangible result, the tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p 21).

Again, by applicant's own admission claims 1 and 19 recite independent acts that "facilitate" the processing of XML items from one format to a second format "that can be" output from the transformation system (Arguments, p 7, second paragraph, lines 9 - 13). The Office maintains that without actually performing or without necessarily requiring that the XML items be output, the result is not made available to the user and thus not tangible and has no practical application. The claimed invention remains in the abstract and does not provide the practical application intended by Applicant.

It should be noted that the arguments regarding 35 USC 112, second paragraph for being indefinite are directed to the newly amended claim language.

Regarding Applicant's arguments that the transformed XML items as claimed must be XML items based on the following disclosure:

Referring initially to Fig. 1, a system 100 for transforming XML items from one representation to another is illustrated.

The system 100 includes a transformer 120 that is adapted to accept XML items from a data source 110 and to apply one or more transformation instructions from a style sheet 130 to the XML items and produce transformed XML items that can be output to a destination data store 140. (Specification, p 10, lines 19 - 23).

Neither the Specification or claims necessarily require that the "transformed" XML items be XML items after the transformation. Within the broadest, reasonable interpretation in light of the specification, XML is interpreted as a format. Therefore, the transformed XML items are in a different format, which can be something other than XML especially if it is not specifically claimed.

It should be noted that the rest of Applicant's arguments regarding 35 USC 103 for not disclosing the claimed output manager as claimed are directed to the newly amended claim language.